

C. APPLICANT'S COMMENTS

Claims 1-5, 8-15, 18, 19 are pending in this Application, with Claims 1, 10, 11 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-5, 8-15, 18, 19 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The Official Action rejected as-filed Claims 1-5, 8, 9, 11-15, 18 and 19 under 35 U.S.C. §102(b) as being anticipated by Hughes. The Applicant respectfully disagrees with this rejection for at least the following reasons.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under 35 U.S.C. §102(b), anticipation requires that the prior art reference both (1) disclose, either expressly or under the principles of inherency, every limitation of the claim, and (2) be enabling thus placing the allegedly disclosed matter in the possession of the public.

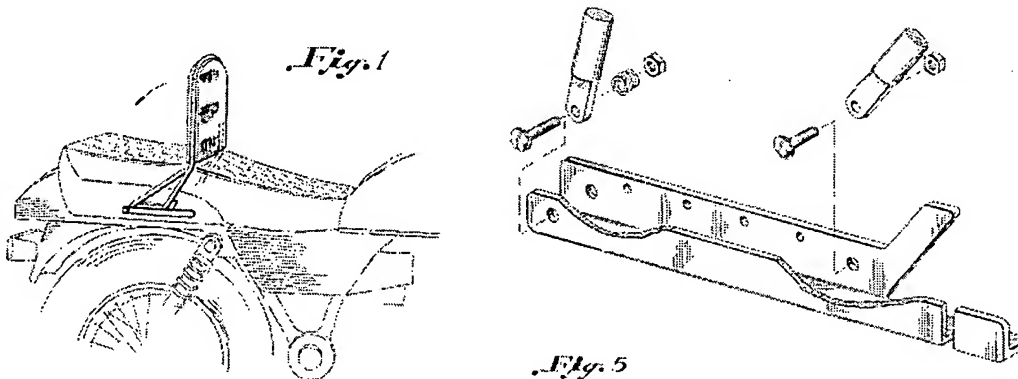
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation also requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int'l Trade*

Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) (emphasis added).

Claim 1 has the following features:

1. (Currently Amended) A motorcycle backrest system, comprising:
 - a backrest;
 - a frame attached to and supporting said backrest, wherein said frame including a pair of front legs extending downwardly and a pair of rear legs extending downwardly and rearwardly at an angle with respect to said front legs, and wherein each of said rear legs includes an engaging end formed to catchably receive a corresponding pair of spacer members attached to a motorcycle; and
 - a pair of receiver members attachable to a motorcycle, wherein said receiver members are comprised of a tubular structure with an upper opening for removably receiving the lower ends of said front legs;
 - wherein said receiver members each have an extended portion with an aperture, wherein said aperture receives an upper threaded fastener of a shock assembly, wherein said extended portion is angled to extend into a tubular portion of a shock assembly.

Hughes (U.S. Patent No. 4,570,998) teaches a motorcycle backrest seat that is pivotally movable from a backrest position for the operator to a seat position for a passenger. Below is an illustration of Hughes (Figures 1 and 5):



The Applicant respectfully submits that Hughes does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Hughes does not disclose (expressly or inherently) all of the features of independent Claims 1, 11. Therefore, Applicant respectfully submits that independent Claims 1, 11 are patentable over the cited reference for at least these reasons. Accordingly, Applicant

respectfully requests that the Examiner withdraw the outstanding rejection as applied to independent Claims 1, 11, since the application is in condition for allowance.

Paragraph 2 of the Office Action

The Official Action rejected Claims 6, 10, 16 under 35 U.S.C. §103(a) as being unpatentable over Hughes in view of Ware. The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

“To establish a prima facie case of obviousness, three basic criteria must be met.” MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different

prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

For these reasons, among others, the combination of Hughes with Ware cannot suggest the combination of features in applicant's Claims 1-5, 8, 9, 11-15, 18 and 19, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-5, 8, 9, 11-15, 18 and 19 allowed.

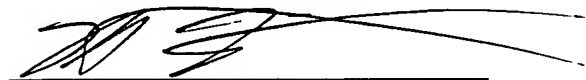
Paragraph 3 of the Office Action

Claims 7 and 17 have been amended into the corresponding independent Claims per paragraph 3.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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